

REMARKS

The last Office Action has been carefully considered.

The Examiner's indication of the withdrawal of the restriction requirement as to the linked species is gratefully acknowledged.

At the same time, the disclosure is objected to.

Also, the claims are rejected under 35 U.S.C. 112 as well as over the art.

In particular, claims 1, 2 and 11 are rejected under 35 U.S.C. 103(a) over the patent to Hecht in view of the patent to Shinma.

At the same time, claims 13 and 14 are considered as allowable.

The Examiner's indication of the allowability of claims 13 and 14 have been gratefully acknowledged.

In connection with this indication, these claims have been retained as they were, with the exception of a minor change in response to the Examiner's rejection of the claims under 35 U.S.C. 112.

In particular, in claims 1, 13 and 14 it has been defined that the drive means is driving the supported in said housing for rotatably driving a tool. It is believed that claims 13 and 14 should be allowed, and also the Examiner's grounds for the formal rejection of claim 1 should be considered as no longer tenable and should be withdrawn.

With the present Amendment applicants have also added claim 15, which is another independent claim and defines that the striker is hollow and surrounds the drive means for driving a tool.

Turning now to the Examiner's grounds for the rejection of the claims over the art, in particular over the patent to Hecht and Shinma, in the Examiner's opinion the feature that the striker is mounted on an outside of the drive means is not disclosed in the patent to Hecht, but could be found in the patent to Shinma in view of the connecting rod 13 defined as a drive means.

The connecting rod 13 of the patent to Shinma serves for compression of the chamber 30 and thereby for driving of the striker 31. A rotatable drive of the tool can not be provided through the connecting rod disclosed in the patent to Shinma. In contrast the present invention specifically defines that the striker is mounted on an outside of the drive means and designed for rotatably driving a tool. This feature is not disclosed in any of the references applied or cited by the Examiner against the original claims. In order to arrive at the applicant's invention from the teachings of the references, the references have to be fundamentally modified. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not disclose anything which would provide any hint or suggestion for such modifications.

The same is true with respect to the features of claim 15 which are not disclosed in the references and can not be derived from them as a matter of obviousness, either taken singly, or in combination with one another.

It is therefore respectfully submitted that claims 1 and 15 should be considered as patentably distinguishing over the art and should be allowed.


In view of the above presented remarks and amendments, it is believed that claims 1 and 15 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233